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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,093	07/11/2003	John Boyle	WEAT/0403	3821
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William B. Patterson MOSER, PATTERSON & SHERIDAN, L.L.P. Suite 1500 3040 Post Oak Blvd. Houston, TX 77056				
EXAMINER				
BEATCH, THOMAS A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/618,093

Applicant(s)

BOYLE, JOHN

Examiner

THOMAS A. BEACH

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 83-115 and 117-120 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 83-115 and 117-120 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 83-97 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Newly added claim language to claim 83 states that the fluid flow is diverted to the storage site via the tap; however, the disclosure does not show how this is *fully* possible since it appears *full diversion* (no production fluid is continuing after the first tap along pipeline 20) is being claimed. The specifications and figures fail to show how this is possible since there is nothing with the first tap or thereafter that prevents the production flow from both continuing to flow in pipeline 20 towards blockage. It appears applicant is claiming to only have production flow (after the first tap) to only go up through 11 to storage.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 83-86, 88-95, 97, 115, 117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amin et al 6,536,528 in view of Hicks 6,012,878. Amin shows the method of intervening in an existing pipeline (including 16 & the pipeline connected to the well 11 to element 10) that transports fluid from an offshore well 11 to a primary location 100, the method having connecting a first tubular 22 between a floating vessel 20 that forms a diversionary path (claim 115) and the pipeline (entire pipeline connecting the well to the hose facility); diverting fluid through the first tubular to a secondary location (unnumbered, col. 3, lines 3-34); capable of connecting a second tubular 18 between the floating vessel and the pipeline; and intervening in the pipeline through the second tubular while fluid is diverted to the floating vessel 20 via the first tubular, where Amin is capable of performing the method of use (such as using 18 to perform functions such as clearing blockage with pigs, chemicals, etc), thus it meets the claimed step since this is obvious to one of ordinary skill to perform these know steps in subsea production, but Amin does not show inserting a tap into the existing pipeline and diverting fluid through the tap.

However, Hicks show a similar subsea pipeline where inserting a tap into the existing pipeline and diverting fluid through the first and second taps 20 & 28 to obviate a damaged portion 12 of the pipeline (fig 1) that will may get a pig stuck (claims 89, 51, 62, 70 and 78; col. 4, lines 20+) causing blockage between the well and storage site (claim 73) capable of having coiled tubing inserted. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Amin, as taught by Hicks, to include the hot tap for the expected result of being able to

quickly and effectively fix damage to the subsea pipeline after in position, thus preventing extensive costs and long down time and the expected result of improve access by making new taps using this tool.

As concerns claims 84-86, 88-95, and 97, Amin shows the system using a coiled tubing 12 (claim 117) for well work, thus including an underbalanced well, downstream, and capable of removing a blockage, such as pig, stuck in the pipeline, descaling the pipeline, removing paraffin from within the pipeline, repairing damage to the pipeline and lowering a coiled tubing into a tap 22 in the pipeline (col. 2, lines 38+), and equivalent functions to analyzing the fluid (col. 3, lines 15-34).

4. Claims 98-113 and 118-120 are rejected under 35 U.S.C. 103(a) s being unpatentable over Amin et al 6,536,528 alone. Amin shows the method of intervening in a pipeline (including 16 & the pipeline connected to the well 11 to element 10) that transports fluid from an offshore well 11 to a primary location 100, the method having connecting a first tubular 22 between a floating vessel 20 that forms a diversionary path (claim 120) and the pipeline (entire pipeline connecting the well to the hose facility); diverting fluid through the first tubular to a secondary location (unnumbered, col. 3, lines 3-34) comprising a storage site on the floating vessel 20 (fig 1; col. 2, lines 57+); capable of connecting a second tubular 18 between the floating vessel and the pipeline; and capable of intervening in the pipeline through the second tubular while fluid is diverted to the floating vessel 20 via the first tubular. Amin does not specifically state these method steps; however, this prior art structure is capable of performing the

method of use, then it meets the claim since this is obvious to one of ordinary skill to perform these know steps in subsea production.

As concerns claims 99-103 and 109, Amin shows the system using a coiled tubing 12 (claim 117) for well work, thus including an underbalanced well, downstream, and capable of removing a blockage, such as pig, stuck in the pipeline, descaling the pipeline, removing paraffin from within the pipeline, repairing damage to the pipeline and lowering a coiled tubing into a tap 22 in the pipeline (col. 2, lines 38+), and equivalent functions to analyzing the fluid (col. 3, lines 15-34).

As concerns claims 104 and 110, Amin shows the coiled tubing is lowered through a moon pool positioned proximate the storage site (fig 1).

As concerns claims 105 and 111, Amin shows the coiled tubing is lowered through a skid deck positioned proximate the storage site (fig 1).

As concerns claims 106 and 112, Amin shows intervening in the pipeline occurs downstream with respect to initial fluid flow through the pipeline to the location from the diverting of the fluid flow to the storage site (fig 1).

As concerns claims 107 and 113, Amin shows intervening in the pipeline comprises removing blockage of the fluid flow within the pipeline (col. 2, lines 38+).

5. Claims 87, 96 and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amin et al 6,536,528 and/or Hicks 6,012,878, as applied to claims 83 and 108 above, further in view of Hansen EP 1184537. The combination does show chemical injection (Amin; col. 2, lines 47+), but does not show injecting acid via coiled tubing; however, Hansen shows a similar passage clearing device similar to Amin/Hicks

having the feature of injecting an acid to remove blockages (scaling) and stimulating the well, thus rendering this method as well known in the petroleum art in which risers and coiled tubing are functional equivalents. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination, as taught by Hansen, to include coiled tubing injection to improve the versatility of the apparatus of removing blockages by having alternate means to perform this operation at remote locations.

Response to Arguments

6. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. The primary reference, Amin, upon reconsideration remains relevant in the 103 since Amin is capable of these processes. Amin, as newly rejection above, shows 22 (as the first tap capable of fluid diversion since it is a riser & in column 2, lines 37-56) can be used to divert fluid. Furthermore, the bop equipment system 10 is type of tap arrangement along pipeline (unnumbered & element 16, that together is a pipeline from well to primary language 100) since the claim language does not preclude this interpretation, merely "forming a tap". Finally, Amin discloses that 22 is a riser 22 and that it is capable of diverting fluid, especially since nowhere in Amin it states that 22 cannot be used for this purpose.
7. Applicant's arguments regarding the secondary references are noted; however, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed

invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Hicks teaches what applicant states that taps are known to those skilled in the art [0051], that taps are known to be used create means18 can be made in situ to remove blockage. Since the primary reference already teaches the diverting of fluid, Hicks is not required to show this (more importantly Hicks is not be used as motivation to teach this aspect either).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Beach whose telephone number is 571.272.6988. The examiner can normally be reached on Monday-Friday, 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571.272.6998. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas A. Beach

/Thomas A Beach/
Primary Examiner, Art Unit 3671

March 12, 2009

THOMAS A. BEACH
Primary Examiner
Group 3600